

03/16/99

# Office Action Summary

Application No.  
**08/963,299**

Applicant(s)  
**Chao et al.**

Examiner  
**HUNG DANG**

Group Art Unit  
**2515**



☒ Responsive to communication(s) filed on Dec 22, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-3, 5, 8-20, 22, 26-30, 33-37, and 40-47 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-3, 5, 8-20, 22, 26-30, 33-37, and 40-47 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 10

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The amendment filed on 12/22/98 has been entered.

#### **Information Disclosure Statement**

2. The Information disclosure Statement filed on 2/1/99 has been considered.

#### **Claims Rejection, Obviousness Double Patenting**

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-3, 5, 8-20, 22, 26-30, 33-37 and 40-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 5,737,054. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention in claims 1-3, 5, 8-20, 22, 26-30, 33-37 and 40-47 of this application is substantially the same as that in claims 1-4 of U.S. Patent No. 5,737,054. All the limitations in claims 1-3, 5, 8-20, 22, 26-30, 33-37 and 40-47 of this application is included in claims 1-4 of U.S. Patent No. 5,737,054 and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus, the scope of the invention in claims 1-3, 5, 8-20, 22, 26-30, 33-37 and 40-47 of this application is substantially identical to claims 1-4 of U.S. Patent No. 5,737,054. Although claims 1-3, 5, 8-20, 22, 26-30, 33-37 and 40-47 of this application does not claimed the exact the location, shape, size and dimension of the connection between the primary and the auxiliary lens frames as that claimed by claims 1-4 of U.S. Patent No. 5,737,054, the location, shape, size, dimension differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears

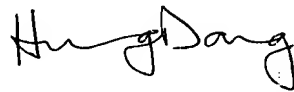
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that these changes produce no functional differences and therefore would have been obvious.

**16.** Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (703) 308-0550.

A handwritten signature in cursive script, appearing to read "Hung Dang".

HUNG DANG

PRIMARY EXAMINER

TC 2800

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